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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,376	04/20/2004	Nozomu Tamoto	252035US DIV	3769
22850	7590	09/06/2007		
OBLON, SPIVAK, MCCELLAND, MAIER & NEUSTADT, P.C.				
1940 DUKE STREET			EXAMINER	
ALEXANDRIA, VA 22314			RONESI, VICKEY M	
			ART UNIT	PAPER NUMBER
			1714	
			NOTIFICATION DATE	DELIVERY MODE
			09/06/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/827,376	TAMOTO ET AL.	
	<b>Examiner</b> Vickey Ronesi	<b>Art Unit</b> 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 24 August 2007.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1,2,7-26,28-32,47-51 and 58-63 is/are pending in the application.  
4a) Of the above claim(s) 1,2,7-25,28-32 and 47-50 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 26,51 and 58-63 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/27/06.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_.

### **DETAILED ACTION**

1. The finality of the previous Office action has been withdrawn and thus, the following action is non-final.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. New grounds of rejection are set forth below. Thus, *a 2<sup>nd</sup> non-final Office action is set forth as follows.*

#### ***Claim Rejections - 35 USC § 112***

4. Claim 62 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 62, the phrase at the end of the claims, "a monocarboxylic acid ester compound having a carboxyl group at the end position, or a polyester resin, an ester compound having a carboxyl group at the end position", causes confusion because it is not made clear if this is one of the elements of the alternative group. If these elements (other than polyester resin) are alternative embodiments, the organic compounds are outside the scope of independent claim 26 which requires the organic compound to be an oligomer, polymer, or copolymer.

***Claim Rejections - 35 USC § 102/103***

5. Claims 26, 51, 58, and 60-63 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nakao et al (US 4,559,288).

With respect to claims 26, 51, 58, and 60, the rejection is adequately set forth in paragraph 4 of Office action mailed 3/6/2006 and is incorporated here by reference.

With respect to claims 61-63, Nakao et al discloses that the polymer having an acid value of 10-100 has repeat units of an  $\alpha,\beta$ -unsaturated carboxylic acid (col. 4, lines 45-46), including exemplified copolymer of methacrylic acid and methylmethacrylate (col. 8, lines 47-50).

***Claim Rejections - 35 USC § 103***

6. Claims 26, 51, and 58-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanamori et al (US 6,335,061) in view of Patzschke et al (US 6,329,020).

With respect to claims 26, 51, and 58-60, the rejection is adequately set forth in paragraph 6 of Office action mailed 3/6/2006 and is incorporated here by reference.

With respect to claims 61-63, Patzschke et al discloses polyacrylate rheological additives including preferred carboxyl group-containing polyacrylate copolymers with an acid number of 60-780 (col. 13, lines 52-65).

***Response to Arguments***

7. Applicant's arguments filed 8/24/2007 have been fully considered but they are not persuasive. Specifically, applicant argues that the data in the application as originally filed and

in the 37 CFR 1.132 Declaration filed 12/23/2005 establish criticality for the process of mixing the ingredients in an alumina ball mill in the product-by-process claim.

In response to the argument, the data is considered to be insufficient to establish a criticality for mixing with an alumina ball mill since the data is not reasonably commensurate in scope with the present claims. While the alumina ball mill improves the dispersion of the exemplified composition containing alumina as filler and a polycarboxylic acid polymer with an acid value of 35-365 as the organic compound, there is no suggestion that all compositions encompassed by the composition limitations would also exhibit such improved properties when mixed with a ball mill containing only alumina balls. In particular, the prior art discloses coating compositions comprising other organic compounds having acid values that fall within the claimed range but are not included in the examples which would not necessarily be affected by a process of mixing in a ball mill containing only alumina balls. Case law holds that “[i]f the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Note that claim 60 does not include product-by-process language. Furthermore, there are no relative amounts recited in the claims and therefore the data is also not reasonably commensurate in scope with the scope of the claims. Case law holds that whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the “objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support.” In other words, the showing of unexpected results must be reviewed to see if the

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results occur over the entire claimed range (i.e., scope). *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980), MPEP 716.02(d).

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8/30/2007  
Vickey Ronesi



/Callie Shosho/  
Primary Examiner  
Art Unit 1714